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09/896,429	06/29/2001			HO-P02234US0		
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		WORSKI, LLP	EXAMINER			
1301 MCKIN SUITE 5100		10 2005	FARAH, AHMED M			
HOUSTON,	1X //0	10-3095		ART UNIT	PAPER NUMBER	
				3739		
			DATE MAILED: 01/31/2003			

Please find below and/or attached an Office communication concerning this application or proceeding.



Application No. 09/896,429

Applicant(s)

MF

Scholler et al.

Office Action Summary

Examiner

A. Farah

Art Unit **3739**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIREthreeMONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. Contensors of the reads we stables were the previous of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed eiter SIX (ii) MONTHS from the making date of this communication. If the period for reply is specified above, the maximum statutory period will spely end will expire SIX (iii) MONTHS from the mailing date of the communication. If No period for reply is specified above, the maximum statutory period will spely end will expire SIX (iii) MONTHS from the mailing date of the communication. If NO period for reply is specified above, the maximum statutory period will spely end will expire SIX (iii) MONTHS from the mailing date of the communication. If NO period for reply is specified above, the maximum statutory period will spely end will expire SIX (iii) MONTHS from the mailing date of the communication. If NO period for reply is specified above, the maximum statutory period will spely end will expire SIX (iii) MONTHS from the mailing date of the communication. If NO period for reply is specified to be considered to the communication. If NO period for reply is specified above, the maximum statutory period will spely end will expire SIX (iii) MONTHS from the mailing date of the communication. If NO period for reply is specified above. If If NO period for reply is specified above. If NO period for reply is s		The MAILING DATE of this communication appears	on the cover	sheet with	the correspondence address	
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Fallure to reply within the set or extended parcel for reply will, by statutes, cause the application to become ABANDONED (13) to S.C. § 133). Any reply recorded by the Office lest than those months after the malling date of this communication, even if tirrely filed, may reduce any seared patent term adjustment. See 37 CFR 1.704(a). Status 1) Responsive to communication(s) filed on Nov 1, 2002 2a) This action is FINAL. 2b) This action is non-final. 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. Disposition of Claims 4i) Claim(s) 1-18	- If the pe	riod for reply specified above is less than thirty (30) days, a reply within th				
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Claim(s)	5) 🗌 (Claim(s)		,	is/are allowed.	
Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on	6) 💢 (Claim(s) <u>1-18</u>			is/are rejected.	
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The proposed drawing correction filed on	10)	The drawing(s) filed on is/are	a) 🗆 accep	ted or b)[\square objected to by the Examiner.	
If approved, corrected drawings are required in reply to this Office action. 12) The oath or declaration is objected to by the Examiner. Priority under 35 U.S.C. §§ 119 and 120 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some* c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). *See the attached detailed Office action for a list of the certified copies not received. 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) The translation of the foreign language provisional application has been received. 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. Attachment(s)		Applicant may not request that any objection to the d	rawing(s) be l	held in abe	yance. See 37 CFR 1.85(a).	
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	_		4) Interview	Summary (PTC	0-413) Paper No(s).	
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)	_		_			
3) X Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 and 8 6) Other:			6) Other:		•	

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DETAILED ACTION

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Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 7 and 13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 29 and 33 of copending Application No. 09/772,539. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

- 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

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art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai (U.S. Patent No. 5,549,632) in view of Swinger et al. U.S. Patent No. 6,325,792 B1) and in view of Davidson (U.S. Patent No. 5,282,088).

Lai discloses ophthalmic surgery apparatus and method for determining and controlling the location of interaction point between a patient's eye and surgical laser beam, the apparatus comprising:

an interface 109 adapted to couple the patient's eye to a surgical laser 100 (see Fig. 1); an attachment means 115 adapted to overlay the anterior surface of the eye to provide stable engagement to the eye (see Fig. 2); and

an applanation lens 111 mounted to the attachment means (see Fig. 4C), the applanation lens having an applanation surface configured to contact the eye, and therefore, applanate or flatten the anterior surface of the eye upon application of pressure.

As to claims 13-18, Fig. 4C of Lai teaches the use of a suction ring 501 adapted to the bottom surface of the interface so as to stabilize the position of the interface relative to the operative area of the eye.

Lai further teaches that his laser provides a laser beam suitable for ophthalmic surgery (see Claim 1, lines 4-5). However, although he describes the use of various known ophthalmic surgery lasers, which would provide the wavelength ranges of the instant claims (i.e., 275 nm -

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2500 nm), he does not particularly specify the type of laser used with his invention. He further fails to teach the material in which the applanation lens is made of, or its relative transmission in the laser wavelength.

Swinger et al. teach an alternative ophthalmic surgical apparatus and method comprising: an ultraviolet (UV) laser **52**, which provides the ablation energy (see Col. 28, lines 8-17); and an applanation lens **78** having an applanation surface configured to contact the patient's eye (see Fig. 15D; and Col. 26, lines 21-27). Their applanation lens transmits the ablative laser beams produced by the UV laser. However, although their applanation lens is configured to transmit the irradiated UV, they do not teach the material in which the lens is being formed.

Davidson teaches an applanation lens which has no, or negligible, spherical aberration on or near its axis. He teaches that if the lens is made from a fused silica, then it is transparent in the UV, down to about 180 nm. In this Office Action, the lens of Davison, which is made from a material that is analogous to materials of the instantly claimed lens, is treated to have 'a purity great enough to resist discoloration upon prolonged irradiation produced by high energy irradiation sources such as UV, X-rays, gamma rays, etc.'

Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Lai with Swinger et al. and use a UV laser as an alternative source to provide the ablation energy. The use of UV-grade lenses to transmit the maximum in the intensity/energy of an irradiated UV light is well know art. Hence, it would have been further obvious to one skilled in the art to modify Lai with Swinger et al. and in view of Davidson to



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make the applanation lens from a fused silica or material that transmits UV light, and withstands prolonged high-energy irradiation such as UV, X-rays, or gamma rays in order to avoid discoloration/degradation that may be subjected to the lens. The use of such lens would maintain/prolong the integrity of the lens, and therefore, would be cost effective. It would further eliminate the time needed to re-align a surgical system with an ordinary glass lens in the case the lens is damaged and its focusing properties changed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The fax number for the Examiner is (703) 746-3368.

A. M. Farah

Patent Examiner (Art Unit 3739)

Linda C. M. Dvorak

Supervisory Patent Examiner

January 25, 2003